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EXAMINER

YEAGLEY, DANIEL S

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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/815,202
Filing Date: March 31, 2004
Appellant(s): CASSONI, ROBERT P.

William C. Gehris
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/19/06 appealing from the Office action mailed 2/13/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,454,576	Pitkanen	10-1995
5,738,261	Dula	4-1998
2,577,290	Underwood	12-1951

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made:

Claims 1, 3, 4, 5, 8, 9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitkanen '576 in view of Dula '261.

Pitkanen shows a golf club carrier comprising a handle with a golf bag comprising a back, front, bottom and open top which is supported by a first side of a carrier body which supports the back and bottom of the golf bag (figure 5), wherein the carrier body comprises two wheels connected to and extending from a second side of the carrier body, such that the carrier is capable of standing upright when a support surface and the wheels contact the ground, and wherein the wheels include an axis that are movable with respect to the carrier body (figure 1), and further shows a device (mounting claw 53) connected to the carrier body, such that at least a portion of the device extends from the first side at the bottom of the golf bag (figure 5) and is capable of connecting to a hitching device on a golf cart (vehicle), but was silent regarding a hitching device connected to the carrier body for connecting to another hitching device which permits rotation of the golf club carrier body about the other hitching device.

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Dula shows a carrier having a carrier body and handle that is capable of holding a golf bag, wherein the carrier body of Dula discloses the prior art of incorporating a hitching device to a carrier body to connect the carrier body to another hitching device on a vehicle (cart), wherein at least a portion of the hitching device extends from a first side of the carrier body and permits rotation of the carrier body about the other hitching device (column 11, figure 1 and 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the carrier of Pitkanen utilizing a securing hitching device such as suggested by Dula carrier, in order to extend the use of Pitkanen carrier and provide a hitching means to secure the carrier of Pitkanen to a vehicle to provide for easy transporting of the carrier which minimizes the labor and difficulty of attaching and removing a cart from a vehicle as disclosed by Dula, which discloses a simple hitch style securing device for securing a carrier to a vehicle for easy transport of a carrier.

Claims 2, 6, 7, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitkanen '576 as modified by Dula '261 in further view of Underwood '290.

Pitkanen as modified by Dula as stated above disclosed a carrier comprising a carrier body, handle and two wheels extending from a second side of the carrier that are retractable and move an axis of the wheels with respect to the carrier body, and wherein the carrier body as modified by Dula hitching device has at least a portion of the hitching device extending from a first side of the carrier body and permits rotation of the carrier body about another hitching device on a vehicle (column 11, figure 1 and 4), but failed to show a spring connected to the wheel for assisting in retracting the wheels which included axis of the wheels being movable via a handle,

Underwood as stated above, disclosed a carrier that incorporates two wheels being connected to a carrier body and extending from a second side of the carrier body having a handle that is latchable and is also rotatable to move the axis of the wheels with respect to the carrier body (column 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified the modified carrier of Pitkanen as modified by the hitching device of Dula with spring biased retractable wheels and latchable handle to more easily control the actuation of the retractable wheels of Pitkanen carrier utilizing a single movement handle for an actuating member to manipulate the wheels to an extended locked position as taught by Underwood (column 1).

Claims 14 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dula in view of Underwood '290.

Dula shows a carrier having a carrier body and handle, wherein the carrier body includes a hitching device connected to a carrier body for connecting to another hitching device on a vehicle (car), wherein at least a portion of the hitching device extends from a first side of the carrier body and permits rotation of the carrier body with respect to the vehicle (column 11, figure 1 and 4), but failed to show the two wheels connected to and extending from a second side of the carrier body.

Underwood shows a carrier that incorporates two wheels being connected to a carrier body and extending from a second side of the carrier body (figure 1), wherein the carrier includes the prior art features of having a handle that is latchable (column 3, line 38) and is rotatable to move the axis of the wheels with respect to the carrier body (column 3) as claimed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the wheels of Dula carrier with rearward mounted movable wheels that are collapsible via a handle actuation such as suggested by Underwood to provide a carrier that is substantially more compact for storage as taught by Underwood.

(10) Response to Argument

Applicant's arguments filed 10/19/069 have been fully considered but they are not persuasive.

Regarding applicants' arguments that the foot member 53 of Pitkanen is not a hitching device and is not capable of connecting to another hitching device on a golf cart is not persuasive. As applicant noted, Pitkanen foot member 53 *supports a pull cart* so it can stand and the foot support element of Pitkanen golf club carrier (cart) is clearly capable of standing in a hitching device, much like the pull cart foot element 27 that is shown in the Dula hitching device (figure 1 and 4). Wherein the foot element can obviously support the pull cart (i.e., carrier) in a standing position either contacting the ground or when inserted into the claw type hitching means as disclosed by Dula. Dula clearly discloses a *pull cart* that is supported by a supporting foot element in order to hitch the cart to another hitching device on a relatively small vehicle (Dula, column 1, line 5-45) and is equally applicable and usable in transporting other carriers designed to carry various equipment upon other vehicles (Dula, column 11, line 25-27) and therefore is suggestably obvious to one of ordinary skill in the art that the hitchable means of Dula is capable of being hitch to another type of small vehicles, such as a golf cart (car) and is clearly capable of carrying various equipment, such as a golf bag. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be

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the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., another hitching device on a golf cart) is not positively recited in the rejected claim(s). Applicant should note that the recitation relied upon, i.e.; "hitching device ... *for* connecting to another hitching device on a golf cart" is only considered a recitation of the intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim and Pitkanen as modified by the hitching means of Dula clearly suggests these features. Applicant's argument that Dula does not teach a golf club carrier, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Regarding applicants' arguments pertaining to claims 3 and 11, applicant should note that there is nothing in the claims that would distinguish that the support surface must be a separate component from the hitching device as argued; but argumentative, the references to Dula and Pitkanen show the bottom surface of their foot members being a supporting surface component and the hitching device being the tubular bar component; therefore separate components as broadly read.

Regarding applicants' arguments to claims 4 and 12, pertaining to the term "mount claw", Dula and Pitkanen show a claw element 27 and 53; respectively, which are capable of being inserted into another hitching device on a vehicle as modified by the hitching device of Dula, wherein the term "claw" by definition is being read as "any of a various sharp curved processes esp. at the end of a limb" (Merriam Webster's Collegiate Dictionary; Tenth Edition); wherein the limb is the bar element and the sharp curved process (claw) being the curved surface of the bar element which is inserted into a cupped shaped element of the other hitching device on the vehicle, however, argumentative, Dula further shows the hitching device on the vehicle with a concaved retaining portion resembling the inward portion of a claw shape where the other hitching member is inserted into the inward curved portion of the claw, argumentative then it is held that mere reversal of essential working parts of a device involves only routine skill in the art and would have been obvious to one of ordinary skill in the art at the time the invention was made to have reversed these elements. In re Einstein, 8 USPQ 167.

In response to applicant's argument that Underwood does not disclose any motivation or reason to modify Dula or Pitkanen, Underwood was only cited as showing the prior art of utilizing a spring means and a handle with retractable wheels which clearly provides a motivation for automatically locking wheels on a golf carrier for transportation over a course and for easily collapsing the wheels to provide storage of the wheels where space is at a premium as disclosed by Underwood (column 1).

(11) Related Proceeding(s) Appendix


No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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